

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WALTER H. WHITLOCK

Appeal 2007-0630
Application 10/643,597
Technology Center 1700

Decided: July 30, 2007

Before EDWARD C. KIMLIN, PETER F. KRATZ, and LINDA M.
GAUDETTE, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This case is not ripe for review and pursuant to 37 C.F.R. § 41.50(a) (2004), we remand this application to the Examiner to take appropriate action consistent with our comments below.

Any initial inquiry into the propriety of the Examiner's prior art rejections requires the determination of the scope of the claimed subject matter. *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed.

Cir. 1994). We observe that independent claims 13 and 14, as well as dependent claim 15, on appeal, are drawn to a system for cleaning semiconductor wafer surfaces having, *inter alia*, mechanical elements defined by means-plus-function limitations. Claim 13 recites “a means for applying an elevated pressure ...”, and claim 14 requires two separate such means. Claim 15 requires “a means adapted to receive and mix” The appealed process claims recite corresponding steps.

When the claimed elements are defined by means-plus-function and/or step-plus-function limitations, we must interpret them as being limited to the corresponding structures described in the specification and the equivalents thereof consistent with 35 U.S.C. § 112, 6th paragraph. *In re Donaldson Co.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994)(en banc). The Specification must disclose the corresponding structures of the claimed means-plus-function limitations in such a manner that one skilled in the art would know and understand what structures correspond to the claimed means-plus-function limitations. *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999).

According to 37 C.F.R. § 41.37(c)(1)(v)(2004), the Appellant is required to identify “every means plus function and step plus function as permitted by 35 U.S.C. [§] 112, sixth paragraph,” and set forth “the structure, material, or acts described in the specification as corresponding to each claimed function . . . with reference to the specification by page and line number, and to the drawing, if any, by reference characters” in the Summary of Claimed Subject Matter section of the Brief. However, the

Appellant has not done so. For example, Appellant refers to page 4, lines 15-21 of the Specification for claim 13 and page 4, lines 22-31 of the Specification for claim 14 (Br. 8). However, those referred to passages in the Specification do not define structure corresponding to the claimed means plus function limitations. Nor has Appellant clearly specified every corresponding structure that may be disclosed in the Specification and linked the functions of any such structures to each respective means-plus-function limitation recited in the appealed claims.

37 C.F.R. § 41.37(d)(2004) states that:

If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

Thus, upon return of this application, the Examiner must notify Appellant of the above deficiency in the Brief and require the Appellant to submit an amended Brief to correct it within an appropriate time period. Upon receiving the amended Brief, the Examiner must review the Brief to determine (1) whether it meets the requirements set forth in 37 C.F.R. § 41.37(c)(1)(v)(2004) and (2) whether the structures disclosed in the Specification are clearly defined and linked to the claimed means-plus-function limitations in compliance with 35 U.S.C. § 112, second paragraph. Also, the Examiner should submit a Substitute or Supplemental Answer

directed to any such amended Brief submitted if the rejections are to be maintained.

The Supplemental or Substitute Answer can be used to further explain the rejection of record in terms of the specific structures described in the Specification allegedly corresponding to the claimed means-plus-function limitations or equivalents thereof. The Examiner is reminded that the structures taught or suggested in the prior art reference are considered “equivalents thereof” if they, relative to the corresponding structures,

1) perform substantially the same function in substantially the same way to produce substantially the same result, *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267, 51 USPQ2d 1225, 1229-30 (Fed. Cir. 1999);

2) have insubstantial differences, *Valmount Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1042-44, 25 USPQ2d 1451, 1453-56 (Fed. Cir. 1993);

3) are structurally equivalent, *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990); and

4) would have been recognized by one of ordinary skill in the art as interchangeable, *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1316, 50 USPQ2d 1161, 1165 (Fed. Cir. 1999).

If the Specification fails to adequately describe the structures corresponding to the claimed means-plus-function limitations in a manner such that that one skilled in the art would know and understand what structures correspond to the claimed means-plus-function limitations, the Examiner must set forth a new ground of rejection under 35 U.S.C. § 112, second paragraph, and reopen the prosecution of this application.

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This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this remand by the Board.

REMANDED

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